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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,898	01/05/2001	Mark Miller Chesser	051273-0126	5026
59555 7590 04/04/2008 RATHE PATENT & IP LAW 10611 W. HAWTHORNE FARMS LANE MEQUON, WI 53097				
EXAMINER				
DOAN, DUYN MY				
ART UNIT		PAPER NUMBER		
2152				
MAIL DATE		DELIVERY MODE		
04/04/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/755,898

Applicant(s)

CHESSER, MARK MILLER

Examiner

DUYEN M. DOAN

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,12-14,16-20,22-25,29-30,34-37 and 40-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,12-14,16-20,22-25,29-30,34-37 and 40-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In view of the Appeal filed on 1/3/2008, PROSECUTION IS HEREBY REOPENED. The new rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Bunjod Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152

Examiner's interpretation of the claim invention

The wireless device with the internet capability, the button on the keypad of the wireless device being pressed to input the code. The code will be send to the server, and receive by the interface of the server. The programmable device either locates at the server or connected to the server finds the output character associated with the

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code inputted by the wireless device and send the output character to an application program.

Claim Objections

Claim 40 is objected to because of the following informalities:

A ":" should be added after the word "comprising".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 48-50, 53-55, 58-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment filed on 9/18/2006 included the newly added limitation cited in claims 48-50, 53-55, 58-60, the newly added limitations are as follows: "the input code

excludes a phone number" and "the input code is not transmitted to the application program" the disclosure as original filed does not disclose the added limitation.

Applicant is required to either provide support by original specification for "the input code excludes a phone number" and "the input code is not transmitted to the application program" or cancel this limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3-6,12-14,16-19,44,46-50, 53-55,58-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,3-6,12-14,16-19,44,46-50 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

Independent claim 1 cites, "receiving an input code from wireless Internet enable device via a server computer...locating in a programmable device at least one user-specified output character associated with the user entry button in response to receipt of the input code..." there is no structural relationship between the server and the programmable device, Is the programmable device part of the server ? Or in connecting

with the server? How does the programmable device know what input code inputted so it use that input code to associate the output character .

As regard to claims 48-50, 53-55, 58-60 , applicant define the invention in terms of what it was not, rather than pointing out the invention, thus limitation "the input code excludes a phone number" and "the input code is not transmitted to the application program" were the negative limitations that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-6,12-14,16-20,22-25, 29-30,34- 37 and 40-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran (us 2002/0073142) in view of Wilk (us pat 6,768,789).

As regarding claim 1, Moran discloses a method of producing custom output in response to user input received using a wireless Internet-enabled device having a plurality of user entry buttons, the method comprising:

receiving an input code from the wireless internet-enabled device via a web interface of a server computer, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet enabled device by activation of the user entry button (see Moran pg.1, par 0010-0012, 0013; pg.3, par 0043, user press the button on the internet wireless enable device to enter the input code, this input code send to the messaging server); and providing said at least one user-specified output character for use by an application program (see Moran pg.1, par 0010-0012, the pre-specified message sends from messaging server to the mail box of the destination party).

Moran does not specifically disclose the concept of locating user-specified output character associated with the user entry button, in response to receipt of the input code; storing a plurality of user-specified output characters associated with the plurality of user entry buttons;

Wilk teaches the concept of storing user-specified output characters associated with the plurality of user entry buttons (see col.3, lines 36-45; col.5, lines 36-55, store the pre-recorded message at the database, the messages associated with the code); locating user-specified output character associated with the user entry button (see col.5, lines 36-55, locating character message associated with input code, for example input code 2 is associated with second message).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Wilk to the method of Moran to include

the input code associate with the character message for the purpose of providing a more convenient for user to response (see Wilk pg.1, par 0013).

As regarding claim 3, Moran-Wilk discloses receiving the input code from a data communications network (see Moran pg.1, par 0004, communication network).

As regarding claim 4, Moran-Wilk discloses receiving said Input code from a communications system in communication with the wireless Internet-enabled device and the, data communications network (see Moran pg.1, par 0004, communication network).

As regarding claim 5, Moran-Wilk discloses receiving said input code from a wireless communications system (see Moran pg.1, par 0012, wireless mobile phone, also see figure.4, device 110).

As regarding claim 6, Moran-Wilk discloses wherein the wireless Internet-enabled device is a wireless telephone (see figure.4, device 110).

As regarding claim 12, Moran-Wilk discloses programming said programmable device by associating at least one output character with a corresponding input code and its associated user entry button (see Moran pg.1, par 0010-0012, 0013; pg.3, par 0043).

As regarding claim 13, Moran-Wilk discloses wherein programming associating linguistic phrases with corresponding input codes and the associated user entry buttons (see Wilk col.5, lines 37-56). The same motivation was utilized in claim 1 applied equally well to claim 13.

As regarding claim 14, Moran-Wilk discloses wherein programming comprises receiving said al east one user-specified character from a user input device (see Wilk

col.5, lines 37-56). The same motivation was utilized in claim 1 applied equally well to claim 14.

As regarding claim 16, Moran-Wilk discloses presenting a programming interface to a user, to facilitate receiving said programming commands (see Moran pg.1, par 0010-0012, 0013; pg.3, par 0043).

As regarding claim 17, Moran-Wilk discloses relating a set of input codes and corresponding output characters to a user (see Wilk col.5, lines 37-56). The same motivation was utilized in claim 1 applied equally well to claim 17.

As regarding claim 18, Moran-Wilk discloses relating sets of input codes and corresponding output characters to corresponding users (see Moran pg.1, par 0010-0012, 0013; pg.3, par 0043).

As regarding claim 19, Moran-Wilk discloses locating a set of input codes and corresponding output characters, corresponding to a user determined from said input code (see Moran pg.1, par 0010-0012, 0013; pg.3, par 0043).

As regarding claim 44, Moran-Wilk discloses wherein the data communications network is the Internet (see Moran figure 4, internet 112).

As regarding claim 45, Moran-Wilk discloses he data communications network is the Internet (see Moran figure 4, internet 112).

As regarding claim 46, Moran-Wilk discloses the application program providing a user with a prompt for text input at the wireless Internet enabled device, wherein the input code is received as a response to the prompt at the wireless internet enabled device; and transmitting the response to the application program after the at least one

user-specified output character is substituted in place of the received input code for the response (see Wilk col.5, lines 37-56). The same motivation was utilized in claim 1 applied equally well to claim 46.

As regarding claim 47, Moran-Wilk discloses wherein the response is displayed by the application program on the wireless internet-enabled device with the substituted at least one user-specified output character (see Moran pg.1, par 0010-0012, 0013; pg.3, par 0043).

As regarding claims 48-49, Moran-Wilk discloses the input code excludes a phone number (see Wilk col.5, lines 37-56). The same motivation was utilized in claim 1 applied equally well to claim 48-49.

As regarding claim 50, Moran-Wilk discloses the input code is not transmitted to the application program (see Wilk col.5, lines 37-56). The same motivation was utilized in claim 1 applied equally well to claim 50.

As regarding claims 20, 22-25, 29-30, 34-36, 45, 51-55 the limitations of claims 20,22-25,29-30,34-36,45,51-55 are similar to limitations of rejected claims 1,3-6,12-14,16-19,44,46-50, therefore rejected for the same rationale.

As regarding claims 37, 40-43, 56-60 the limitations of claims 37,40-43,56-60 are similar to limitations of rejected claims 1,3-6,12-14,16-19,44,46-50, therefore rejected for the same rationale.

Examiner's Note:

Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUYEN M. DOAN whose telephone number is (571)272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. M. D./
Examiner, Art Unit 2152

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152